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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,847	05/14/2001	Brian Mathur	LEX-0173-USA	8347

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EXAMINER
SMITH, CAROLYN L

ART UNIT	PAPER NUMBER
1631	

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/854,847	MATHUR ET AL.	
	Examiner	Art Unit	
	Carolyn L Smith	1631	

--The MAILING DATE of this communication appears on th c ver sheet with the correspondence address --

THE REPLY FILED 7/28/03 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☒ A Notice of Appeal was filed on *28 July 2003*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *2, 3, 5, and 6*.

Claim(s) withdrawn from consideration: _____.

8.☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Continuation of 3. Applicant's reply has overcome the following rejection(s): Applicants have overcome the written description rejection of 35 USC § 112, 1st paragraph, the 35 USC § 112, 2nd paragraph rejection, and the 35 USC § 102 prior art rejection due to amendments in claims 2 and 3 which recite encoding of the "entire" amino acid sequence of SEQ ID NO: 2.

Continuation of 5. does NOT place the application in condition for allowance because: The rejections of claims 2, 3, 5, and 6 are maintained under 35 USC § 101 and 35 USC § 112, 1st paragraph. Regarding the utility rejections, Applicants state the information provided by sequences of the present invention have real world economic value as genomic sequence information is of limited value without the individual sequences. Applicants state not all human genomic DNA sequences would be useful in gene chip applications, since only 2-4% of the genome actually contains exons which encode amino acids. This is found unpersuasive as to fulfilling the specific or substantial utility requirements because, merely having an exon does not automatically validate having a substantial utility featuring a "real world" use. This is because it is unknown what readily applicable utility the claimed sequence has without further experimentation. There are many DNA sequences containing exons which can generically be used in gene chip technology, including the claimed sequence; however, such a utility is generic rather than specific. Applicants assert that they provided adequate evidence of utility in determination of the genomic structure of the corresponding chromosome by mapping a specific protein encoding region and that the claimed sequence defines exon splice-junctions. This is found unpersuasive as the mapping of a locus and the presence of an exon splice-junction are phenomena applicable to many DNA sequences, which is a generic utility at best, absent any association to a particular phenomenon, such as a specific disease. Applicants state that the knowledge of the exact function or role of the presently claimed sequence is not required to track expression patterns using a DNA chip. Applicants further state that the claimed sequence provides a specific marker and that specific markers are targets for discovering drugs that are associated with human disease. This is found unpersuasive as Applicants have failed to state which specific disease the marker could be used for drug discovery. Apparently, further experimentation would be necessary to determine which disease the marker is associated with which would demonstrate a real world use of the claimed invention in a readily applicable form. Applicants mention other issued U.S. patents as evidence that DNA chips have utility. This support for utility is found unpersuasive as each patent application is examined relying on its own fact pattern, irrespective of other applications or issued patents. Applicants conclude their utility rebuttal asserting their present invention has utility in both chromosome mapping and the identification of functional intron/exon splice junctions. This conclusion is found unpersuasive as these proposed utilities do not adequately fulfill the specific and substantial utility requirements of 35 USC § 101.
Applicants assert the instant invention has a specific, substantial, and credible utility so that one of ordinary skill in the art would know how to use the claimed invention as required under the enablement provision of 35 USC § 112, 1st paragraph. This is found unpersuasive as the utility requirements have not been adequately met as explained, supra.

ARDIN H. MARSCHEL
PRIMARY EXAMINER